

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN W. COMISKEY
and
BARRETT O. COMISKEY

Appeal No. 95-3656
Application No. 08/240,895¹

ON BRIEF

~~MAILED~~

~~JUL 31 1996~~

~~PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES~~

Re-MAILED

AUG 08 1996

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before ABRAMS, COHEN and JOHN D. SMITH, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1, 2, 6 through 13 and 16 through 19. Claims 3 through 5, 14, 15 and 20 have been withdrawn from consideration as being drawn to a non-elected species (Paper No. 7).

¹ Application for patent filed May 11, 1994.

The appellants' invention is directed to a method of reducing reflected light glare into a human's eyes from the human's cheeks while providing non-verbal communication to others, and to a means for accomplishing this. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A method of reducing reflected light glare into a human's eyes from the human's cheeks while simultaneously providing a non-verbal communication to others, comprising the steps of:

(a) applying underneath the human's eyes, on the human's cheeks, covering a reflective location on the cheeks at which incident direct or indirect light is likely to be reflected into the human's eyes, a non-toxic material having a non-reflective colored and finished exterior in the form of a predefined clearly demarcated geometric shape which provides a no-verbal communication to others; and

(b) within a week after application of the non-toxic material having a non-reflective colored and finished exterior from step (a), removing it.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Sports Illustrated, January 10, 1994, front cover.

"The Original Temporary Tatoos™" brochure, J.B. Marketing, Inc., 1993.

"Game Faces®" brochure, Team Dynamics, 1993.

Anderson's 1993-1994 catalog, pp. 61-63, "Cheek Cheers".

THE REJECTIONS

Claims 2, 6 through 11 and 17 through 19 stand rejected under 35 USC § 112, second paragraph.²

Claims 1, 2 and 8 through 12 stand rejected under 35 USC § 103 as being unpatentable over the conventional use of eye black by athletes, as exemplified by the cover of *Sports Illustrated*, January 10, 1994.

Claims 1, 2, 6 through 13 and 16 through 19 stand rejected under 35 USC § 103 as being unpatentable over conventional temporary tattoos as exemplified by *Team Dynamics, J.B. Marketing, Inc.* and *Anderson*.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellants are set forth in the Brief and the Reply Brief.

OPINION

The examiner has rejected a number of the claims under 35 USC § 112, second paragraph, as being indefinite, and we will treat this rejection below. However, in our review of the claims other instances of indefiniteness have come to our attention, which we choose to treat at the outset. Therefore, pursuant to our authority under 37 CFR 1.196(b), we make the following new rejection:

² The rejection of claims 1, 12, 13 and 16 under 35 USC § 112, second paragraph, was withdrawn by the examiner in the answer.

Claims 1, 2, 6 through 13 and 16 through 19 are rejected under 35 USC § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention, for the reasons set forth below.

Independent claim 1 is directed to a method of reducing reflected glare into a human's eyes from the human's cheeks while providing a non-verbal communication to others. One of the steps is applying underneath the human's eyes, on the human's cheeks and covering a reflective location on the cheeks "a non-toxic material having a non-reflective colored and finished exterior" (lines 6 and 7). It is our view that this phrase contains two instances of indefiniteness.

The first of these concerns the term "non-reflective," which is one of the descriptive modifiers of the material applied underneath the human's eyes. The literal meaning of "non-reflective" is that the material reflects no light, but this meaning would appear to be inaccurate in light of appellants' specification. It is clear to us that the appellants' intention is not to have "non-reflective" so narrowly construed and the claim so limited, in view of the description of the invention in the specification, particularly the opening two pages, and the initial words of the claim, which indicate that the method is to reduce and not eliminate reflected light glare. In fact, a

completely non-reflective material is not mentioned, nor is such implied, anywhere in the record. It therefore is necessary to determine from the specification the interpretation that should be given to the term "non-reflective," as used in the claims.

If "non-reflective" is not to be given its literal meaning, it is, in essence, a term of degree, and a determination must be made as to how much light a material may reflect before it falls outside the range established for the term, for this is a factor in determining the scope of the claims. When dealing with terms of degree, we are directed to look to the specification, which must provide some standard for measuring that degree. *Seattle Box Co., Inc. v. Industrial Crating and Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

The paragraph encompassing lines 3 through 22 on page 2 of the specification is the most relevant to this determination. The first information regarding the material to be used, and thus what constitutes "non-reflective," appears on lines 9 through 11, where it is stated that "[a]ccording to the present invention eye black, or temporary tattoos or decals having basically the same non-reflective properties as eye black," are applied. An eye black labeled "conventional" has been described on the preceding page of the specification, but only by way of the ingredients which are "typically" included (page 1, lines 13 and 14). The level of non-reflectivity of conventional eye black is, however,

not set forth. Moreover, the presence of the modifiers "conventional" and "typically" in this explanation further cloud the issue of establishing a level of light reflection by way of reference to eye black, for these terms imply that there are other eye blacks that do not fall into these categories. The statement that the material used in the invention also may have "basically the same" non-reflective properties as eye black further complicates the issue, for if one has not been apprised of the reflective properties of eye black, one certainly cannot even attempt to determine what is encompassed by the category of "basically the same" as eye black. The net result is that this expression of the characteristics of the material used in the invention by reference to eye black does not establish the guidance necessary to determine the degree of non-reflectivity which is covered by the claims.

The paragraph continues with the explanation that "[u]nlike conventional temporary tattoos and decals . . . [the material] is non-reflective, typically as a dull or matte black or other dark color having a wavelength greater than about 690 nm and less than about 430 nm" (lines 14 through 17). We here observe, however, that no information is provided regarding the reflective characteristics of such "conventional" tattoos and decals, and a comparison of the tattoos and decals and the material of the invention cannot be made, and thus no indication of the breadth

of the modifier "non-reflective" can be established on this basis. Continuing on, the description of the material as being "typically" dull or matte black or other dark color within a band of wavelengths leaves open the possibility that other, not typical, colors are included, interjecting another lack of definiteness. Even the wavelength limits each are preceded by the term "about," therefore adding another uncertainty to the question of what is within the scope of "non-reflective" and what is not.

Finally, the paragraph goes on to state that the material is "non-reflective in the sense that it reflects very little light from the visible spectrum and, therefore, appears dull or matte" (lines 16 through 18). We are at a loss to appreciate the significance of the phrase "in the sense that" or, for that matter, its purpose, other than the presumption that its presence was deemed necessary by the appellants and it adds some limitation to the explanation. From our perspective, it provides an additional degree of uncertainty to the phrase "very little light," which it modifies. Finally, "very little light" is on its own indefinite, for there is no standard established in the record for these words, which clearly are a statement of degree.

We also draw attention to a recitation on page 8 of the specification which indirectly impinges upon the matter of defining the scope of the invention. At this point, the

specification is directed to situations where "functionality can be compromised slightly, or where functionality is not the primary purpose for utilizing the shapes" (lines 12 and 13). We assume that the embodiments here discussed also are intended to be part of the appellants' invention. However, we are unable to appreciate how a situation in which "some white or brighter colors can be utilized . . . or less than the entire conventional reflective area on the cheeks. . . may be covered by the shapes" (lines 13 through 15) is accommodated within the restrictions discussed on page 2 of the specification, or how they can fall within the scope of the claim language, unless the term "non-reflectivity" is very broad and/or inaccurate.

In summary, it is our conclusion that the explanations provided in the specification, as exemplified by the paragraph on page 2, fail to provide the information necessary for one of ordinary skill in the art to ascertain the degree of reflectivity which the appellants wish to have considered as falling within the scope of "non-reflective," without which information the metes and bounds of the claims cannot be determined.

In addition to requiring that the material used in the method be "non-reflective colored," claim 1 goes on to state that the material also must have a "finished exterior." It is our view that the presence of this phrase also renders claim 1

indefinite because its meaning is not clear and therefore the metes and bounds of the claim cannot be determined.

"Finished exterior" as used in the claim constitutes a structural limitation, in the same fashion as does "non-reflective colored." However, while "finished exterior" appears in several places in the appellants' specification, there is no explicit explanation of what it means, nor does an implicit definition that applies to all of the embodiments become apparent. The only one of the common definitions of "finished" which would seem to be applicable is that a coating has been placed upon the surface (*The Random House College Dictionary, Revised Edition*, 1980, page 495). However, if such a meaning is attached to the phrase as used in claim 1, one of the key embodiments of the invention, the application of conventional eye black by means of a stencil (pages 3 and 8) would appear to be outside the scope of the claim, for eye black applied in that fashion does not have an exterior coating. The same would also appear to be true with regard to the temporary tattoos of the type described in the specification.

Claim 17 is directed to a decal or temporary tattoo. The indefiniteness problems discussed above with regard to claim 1 also are present in claim 17, and therefore the foregoing discussion applies to claim 17 also.

Claim 10 recites that the material has a wavelength greater than "about" 690 nm and less than "about" 430 nm. The quoted word constitutes a word of degree which has not been defined in the specification. Absent such guidance, the deviance from the specific values given which is permitted within the scope of this portion of the claim cannot be determined to the extent necessary to establish the metes and bounds of the claims.

A decision as to claim indefiniteness requires a determination whether those skilled in the art would understand what is claimed. *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991). It is our opinion that "non-reflective" has not been defined in the specification in such a fashion as to allow one of ordinary skill in the art to determine what is and is not encompassed by it, and that this is imputed to it as it appears in claims 1 and 17, thus rendering the claims indefinite. In reaching this decision, we particularly focus upon the failure to describe the reflective properties of eye black, if this is to be the measure, and the presence of modifiers such as "basically the same," "conventional," "typically," "about," "in the sense," and "very little," which precede virtually every potentially definitive or limiting term. Likewise, it is our opinion that one of ordinary skill in the art would not be able to determine the meaning of the phrase "finished exterior," as used in claims 1 and 17, or "about" and

"most," as used in claim 10. The need to define the ranges covered by these terms is important, in that a key factor in determining whether the prior art tattoos and decals render the claimed subject matter obvious is their level of reflectivity as compared to that required by the claims.

The fundamental purpose of a patent claim is to define the scope of protection, and hence what the claim precludes others from doing. See *In re Vamco Machine and Tool Inc.*, 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985). It is our conclusion that claims 1, 10 and 17 do not meet this test. The deficiencies of these claims are, of course, imputed to all of the claims dependent therefrom.

The examiner's rejection under the second paragraph of 35 USC § 112 is directed to claims 2, 6 through 11 and 17 through 19. The focus of this rejection are a number of additional instances of alleged indefiniteness, which we shall consider individually, in the order in which they have been presented in the Answer.

Claim 2 adds to claim 1 the requirement that the first step of the invention be practiced within a few hours or less before the start of the athletic contest "so that the material and its location substantially eliminate reflection of incident direct or indirect light." The examiner first takes issue with the presence of the phrase "substantially eliminate reflection,"

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taking the position that "substantially" is an indefinite term. The appellants counter that this term is used in thousands of patents to prevent an infringer from avoiding literal infringement by minor changes (Brief, page 8). In our view, it matters not that "substantially" has appeared in the claims of issued patents. The question here to be resolved is whether this term, as used in this claim, is sufficiently definite as to enable one of ordinary skill in the art to determine the metes and bounds of the claim; that is, how much reflection must be eliminated before reflection is "substantially" eliminated. The appellants have not pointed to passages in the specification as guidelines or standards for providing some measure of what is substantial and what is not substantial. In fact, although terms such as "non-reflective" and "very little" have been used in the specification in the context of describing the reflectivity of the material, "substantially eliminates" has not. And, as we pointed out above with regard to our new rejection of claim 1, these terms also are vague.

The common definition of "substantial" is "ample or considerable amount" (*The Random House College Dictionary, Revised Edition*, 1980, page 1310). From our perspective, there is no information in the record which would enable one of ordinary skill in the art to determine what is a considerable amount of the reflection. For example, does elimination of 90

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percent of the reflection constitute an ample or considerable amount? Or 70 percent? Or 40 percent? The language of a claim must be clear, so that those who would approach the area circumscribed by the claim may readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance, which is to what the second paragraph of 35 USC 112 is directed. See *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204 (CCPA 1970). The importance of this issue is highlighted by the fact that the appellants have argued in response to the examiner's rejection on prior art that the referenced tattoos and decals reflect too much light to meet the terms of the claims (Brief, page 14 *et seq.*). The limits prescribed by the claim must be established before one can decide what is "too much" in comparison to these limits.

We therefore agree with the examiner that, under the circumstances, "substantially" is an undefined word of degree which renders claim 2 indefinite. Dependent claims 6 through 11 inherit this defect.

The second issue raised by the examiner with regard to claim 2 is the use of the alternative statement "direct or indirect light" (emphasis added). The appellants argue that the intent here was not to present an alternative situation, but to refer to all light, that is "the reflection of both types of light, direct and indirect" (Brief, page 7, emphasis added). We therefore

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shall interpret this phrase as if it read direct **and** indirect light, and on that basis we do not consider it to be indefinite.

Claim 9 contains the recitation that the geometric shape be "sized to comply with regulations of any regulatory body which overseas [sic] the athletic contest." Claim 19 has a similar statement. The examiner believes this to be indefinite because a restriction placed by a regulatory body could cause the geometric shape to be incapable of meeting the other conditions of the claim. While we appreciate the examiner's position, we regard this merely as another limitation that must be met if there is to be compliance with the claim, and do not agree that its presence renders the claim indefinite.

As for the limitation of "primarily" black or dark colored area, which appears in claims 9 and 10, it is our view that one of ordinary skill in the art would have understood this to mean that at least over one-half of the affected area must be black or another dark color, examples being given on page 8 of the specification. These do not, in our view, constitute points of indefiniteness.

However, we agree with the examiner that the presence of the modifier "most" in claim 10 gives rise to indefiniteness. According to claim 10, the area in question appears as a dull or matte color having a wavelength greater than about 690 nm and less than about 430 nm, which we presume thus would absorb

whatever light in the visible spectrum falls within the limits set forth. However, the claim requires more, stating that "and" the dull or matte color absorbs "most" of the light in the visible spectrum. This raises the issue of how much of the light constitutes "most" of the light, especially in view of the wavelength limitations previously specified. It also is possible to interpret the "most" phrase as merely being a confirmation that meeting the wavelength requirements causes most of the light in the visible spectrum to be absorbed. Either way, however, the presence of this undefined word of degree renders the claim indefinite because the metes and bounds of the claim cannot be determined.

The final items of indefiniteness raised by the examiner concern the phrases "dimensioned to substantially cover the area," and "sufficient . . . to substantially eliminate the reflection," which appear in independent method claim 17. As we have stated previously in this opinion, "substantially" is a word of degree for which accompanying limitations and/or definition must be found in the specification. As was the case with the use of this term in claim 2, no such evidence has been provided, and therefore the metes and bounds of the claim cannot be determined. How much is denoted by "substantially" is particularly important with regard to this apparatus claim, because it is impossible to evaluate the applicability of the applied prior art unless the

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definition of the term is established. Of further concern is that by basing the size of the article to which claim 17 is directed on the size of the human who will wear it, the situation arises where the claim covers the article when considered for use, or actually used, by a human of one size, while it does not cover the same article when considered for use, or actually used by, a human of another size. The indefiniteness given rise by this situation is aptly demonstrated by observing that the cited prior art, which consists of tattoos and decals which can be applied to the cheeks of a human, might or might not meet the terms of claim 17, insofar as their size is concerned.

The examiner's rejection of claims 2, 6 through 11 and 17 through 19 under the second paragraph of 35 USC § 112 is sustained.

Claims 1, 2 and 8 through 12 have been rejected by the examiner as being unpatentable over the conventional use of eye black by athletes as exemplified by the cover of *Sports Illustrated*, January 10, 1994, and claims 1, 2, 6 through 13 and 16 through 19 as being unpatentable over temporary tattoos as exemplified by *Team Dynamics, J.B. Marketing, Inc.,* and *Anderson*.

When no definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385,

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165 USPQ 494, 496 (CCPA 1970). Since it is clear to us that considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed, and since a rejection under 35 USC 103 cannot be based upon speculation and assumptions, we are constrained to reverse both of the examiner's rejections under Section 103. *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). We hasten to point out, however, that the actions we have taken should not be construed as an indication that the claimed subject matter would not have been obvious in view of the prior art cited against the claims. We have not addressed this issue, for to do so would require on our part the very speculation which formed the basis of the rejections under Section 112.³

We have, of course, carefully considered all of the arguments presented by the appellants, not only as they apply to the rejections presented by the examiner, but also as they may impact the new rejection which we have entered. However, these arguments have not persuaded us that the new rejection should not be entered, or that the examiner's rejection under Section 112 should not be sustained. Our position with regard to each of the

³ We observe that the tattoos and decals cited by the examiner as references against the claims are represented only by illustrations in brochures, and not by way of the items themselves. Thus, the actual characteristics of their surfaces are not of record, and the positions taken by the examiner and the appellants are based upon their unsubstantiated opinions, and not upon an examination of the articles themselves.

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arguments which pertains to the issue of the indefiniteness of the claims should be apparent from a reading of this opinion. We have two additional comments, however. First, we wish to reinforce our belief that in this particular case it is very important to provide a definite meaning for the words of degree, in view of the fact that the applicability of the tattoos and decals which constitute the closest applied prior art depends upon this definite meaning. Second, while we appreciate that the appellants disagree with the positions reached by the Patent and Trademark Office and we would expect zealous representation of their points of view, nothing is served by alleging that the motivation for taking these positions was anything other than the desire to fairly evaluate the patentability of the claims in accordance with the laws, rules and regulations which govern the examination process (Reply Brief, page 6, line 9 through 13). Attention is directed to 37 CFR 1.3 and Section 714.25 of the Manual of Patent Examining Procedure.

Summary:

The examiner's rejection of claims 2, 6 through 11 and 17 through 19 under 35 USC § 112, second paragraph, is sustained.

The examiner's rejection of claims 1, 2 and 8 through 12 under 35 USC § 103 on the basis of the conventional use of eye black is not sustained.

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The examiner's rejection of claims 1, 2, 6 through 13 and 16 through 19 under 35 USC § 103 on the basis of conventional temporary tattoos is not sustained.

Pursuant to 37 CFR § 1.196(b), claims 1, 2, 6 through 13 and 16 through 19 are rejected under 35 USC § 112, second paragraph.

The decision of the examiner is affirmed-in-part.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR 1.197).

With respect to the new rejections under 37 CFR 1.196(b), should appellants elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellants elect this alternate option, in order to preserve the right to seek review under 35 U.S.C. 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment

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or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED-IN-PART
37 CFR 1.196(b)

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JOHN D. SMITH
Administrative Patent Judge

BOARD OF PATENT
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